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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,203	04/26/2001	Scott N. Barton	END-755	8820

27777 7590 10/19/2005  
PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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SHAY, DAVID M

ART UNIT	PAPER NUMBER
3735	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/843,203		BARTON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	david shay		3735	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on August 1, 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Applicant argues that Novak, Jr. et al. do not teach or suggest at least one or more claim limitations set forth in claims 1-5. Then applicant then asserts that Novak, Jr. et al. does not teach an optical fiber having a treatment region, a first depth indicating region and a second depth indicating region, whereby the primary depth indicating region originates with a first primary mark and terminates with a third primary mark. And that in particular, it is not seen how a first and third ones of the markings 36 of Novak Jr. provide a first depth indicating region. The examiner must respectfully note that Novak specifically discloses that the marks therein can be used for determining depth. For example, column 8, lines 43-48 "a surgeon may not only control the direction of radiation emitted from closer fiber when the distal end of the laser fiber is obscured from vision, but may also determine the depth to which the laser fiber is inserted into the swollen tissue." Thus clearly, the marks of Novak, Jr. et al. may indicate depth and are even disclosed as being used for such. And any two marks on the device of Novak, Jr. et al. may be arbitrarily designated as a "first mark" and a "third mark" and provide a depth indicating region as claimed. If applicant disagrees with this analysis, the examiner respectfully requests that applicant point out the structure that is lacking from Novak, Jr. et al. that will prevent the marks from being used as a depth-indicating region. It is further noted that in column 8, lines 27-28 Novak, Jr. et al. discloses that an exemplary linear mark "is 4 cm long and is broken so as to form 20 segments" thus, the extent of the distance between the beginning of one linear mark and the beginning of the next linear mark would indicate a spacing of 5 mm. Clearly, the first and third primary marks of Novak, Jr. et al. may be selected so that one of the marks between them resides at the halfway point of the space between the primary marks. Applicant has provided no particular definition for the terms "primary mark" or "main mark" in the originally filed

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disclosure and therefore, any type of mark will read on these terms thus clearly the marks on the device of Novak, Jr. et al. reads on the marks as claimed. Applicant's arguments, which merely state, that the marks of Novak Jr. do not read on the claimed marks without providing any explanation of the way in which the claimed marks are structurally distinguished from the marks of Novak, Jr. are not convincing.

With regard to Rowland et al., applicant requests the examiner point out how claims 14 and 15 are anticipated thereby. Rowland clearly provides an instrument (see for example figure 1), the instrument is intended to be inserted in the tissue e.g. a structure (see column 4, lines 12 to 16); the device has a plurality of markings which allow the depth in the structure that the device has been inserted to be determined (see column 4, lines 16 to 23). As to claim 15, the markings are defined by coloring and grouping to be markedly different from one another as set forth in column 7, lines 1 to 50. Clearly L2 would be about 7 cm from the radio opaque mark 60 and mark 72, of the group of marks that is a distance L5 from the radio opaque mark, if the marks are arranged as set forth in column 7. Thus clearly claims 14 and 15 are anticipated by Rowland et al. Similarly, with respect to the limitations recited in claim 16 and 17, these claims merely require that marks be located on either side of the halfway point mark between that mark and the first and second primary marks. While these marks are referred to as "midway" marks, the designator "midway" is merely a tag, and the broadest reasonable interpretation of this language does not require that these marks be in any particular position between the halfway point mark, and either of the primary marks. In fact, there is no strict requirement that the halfway point mark be at the point exactly halfway between the two primary marks. However, regardless of the interpretation attributed to this term, Rowland et al. still read on the recitation

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thereof for the reasons set forth above. With respect to claim 22, as the recitation regarding the arrangement of the marks is substantially the same as that in claim 14, the anticipation thereof by Rowland et al. applies for substantially the same reasons as claim 14. Once again, in discussing the rejections. Applicant has chosen to simply state that the claims are not anticipated with a proffering any particular structural difference that is perceived to exist between the reference and the claims.

With regard to the rejections under 35 USC 103. Applicant argues that because the two references come from separate subclasses and classes that they are not combinable. However, the examiner notes that both references are concerned with determining the depth into tissue that an instrument has been inserted. Thus the references are combinable for the different aspects of this function that they teach Rowland et al. teaching the use of markedly different marks to clearly delineate the depth in tissue at the devices inserted at a glance, while Novak Jr. teaches means of determining the directionality of the effector that has been inserted into the tissue. The use of circumferential marks, which are markedly different from one another, in addition to the linear marking on Novak Jr. would confer the additional advantage of unambiguously indicating the depth to which the device had been inserted with relative speed and ease. As one of the goals of Novak Jr., in addition to indicating the directionality of the device, is also indicating the depth, this constitutes an appropriate motivation to combine these two references.

Applicant's request to make the instant action non-final is noted, however, as applicant has merely claimed a group of marks; and as the examiner has provided references which clearly display similar groups of marks and which are even used for applicant's disclosed purpose; and as applicant has not sought to point to any structural distinction of the claimed marks and those

of the references, the examiner deems a final rejection to be in order.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Novak, Jr. et al.

See figure 1 and column 5, line 27 to column 8, line 61.

Claims 14-18 and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rowland et al ('115).

Claims 6-13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak, Jr. et al in combination with Rowland et al ('115). Novak, Jr. et al teach a device such as claimed except the markedly different marks and the circumferential marks. Rowland et al ('115) teach a device as claimed except putting the marks on an optical fiber per se and the use of discontinuous circumferential marks. It would have been obvious to the artisan of ordinary skill to include the circumferential markings that are markedly different from each other as the markings on the fiber of Novak, Jr. et al, since the will enable distance determination as taught by Rowland et al ('115) or, alternatively, to employ a fiber in the device of Rowland et al, and in either case to provide the various forms of discontinuous markings, since these are not critical and provides no unexpected result, the producing a device such as claimed.

Applicant's arguments filed August 1, 2005 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

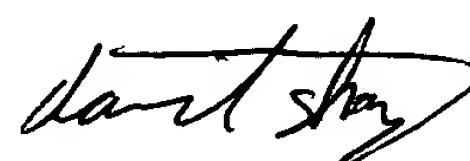
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader, can be reached on Monday, Tuesday, Thursday, and Friday at (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330